

**REMARKS/ARGUMENTS**

Claims 12-15 and 22-31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Alferness. The Applicants respectfully maintain that the most recent Office Action, as with the previous Office Actions, does not establish a *prima facie* case of obviousness in rejecting these claims since Alferness does not teach or suggest each claimed limitation.

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the consideration of every claim feature in an obviousness determination. Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... *ascertaining the differences between the claimed invention and the prior art*. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Indeed, Applicant submits that this is why Section 904 of the MPEP instructs Examiners to conduct an art search that covers "the invention as described and claimed." (emphasis added). Lastly, Applicant respectfully directs attention to MPEP § 2143, the instructions of which buttress the conclusion of the Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In sum, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. See, e.g., *In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003).

For example, Alferness does not teach or suggest a control track for determining which version of at least one complete song audio tracks is to be played. However, Alferness does not teach or suggest a storage medium having audio tracks, each audio track having stored therein a complete version of a song. Rather, Alferness discloses storing individual "sound elements" such as vocals, guitar, bass, drums, etc. (Col. 2, lines 55-58) These elements are mixed according to the controlling script when a selected song is played back. (Col. 3, lines 34-46, col. 6, lines 13-34, col. 6, line 61 - col. 7, line 7) Indeed, nearly EVERY music editing program uses such a "scripting" system to enable dynamic playback of one or more audio tracks in order to compose a song for playback. Indeed, this is the very essence of music production. Alferness, in other words, teaches storing individual sound elements of a song in each track, but not storing a complete song in each track.

In response to this argument, previous Office Actions argued that it would be obvious to record the mixed songs produced by Alferness on a storage medium. We respectfully concur with the examiner on this point. Applicant is certainly NOT claiming that simply burning one or more tracks into a storage medium for playback would be novel. What is novel is using a control script to determine which of the pre-recorded tracks can be played based on one or more trigger points.

While applicant can appreciate that the script of Alferness and control tracks of the present invention appear to perform a similar function, they are actually doing it in a very different way, at different times with very different results. In the world of television, for example, Alferness would be the equivalent of a director of a show. By deciding which actors are on stage, what they say and how that combination is created, the director effectively decides how to create a single show or episode much like Alferness produces a single song. Indeed, one could use the system claimed in Alferness to create the multiplicity of "songs" that are employed by the present invention and avoid requiring the artist to record more than one version of the song.

AFTER those scripts have run and a song has been produced, the present invention and its unique control track may be utilized to establish the timing and ordering of

playback. In the prior art, the ordering of playback was serial or perhaps random—songs were played in order of encoding on the disc (as in an album) or selected at random by a playback device such as an iPod™ or through user selection. The present invention improves that by building a control track around and between one or more (V versions) of the completed songs. Following from the previous analogy, if Alferness is the television director, the present invention provides a powerful tool for the network programming director—the person that decides which day of the week, time and order that the episodes will be viewed. In this case, the present invention gives artists and studios a tool to decide in which order a song would be played and under what conditions—including whether a song has been played and how many times it has been played (Para 40 lines 17-26).

Claim 12, upon which claims 13-15 and 30 depend, recites in part a "storage medium comprising: N number of audio tracks, each audio track having stored therein a complete, previously mixed song; V versions of at least one of the N audio tracks; and *a control track comprising information for determining which of the V versions is to be played.*" (emphasis added)

As explained above, once the individual sound tracks (not songs) from the first medium are played out and mixed under control of the control script of Alferness, the purpose of the control script has been served and there would be no logical reason to use that script during playback of the mixed song. Therefore, Alferness does not teach or suggest a storage medium with a number of audio tracks, each audio track having stored therein a complete version of a song and a control track comprising information for determining which version of at least one of the audio tracks is to be played. For at least these reasons the Applicants maintain that the rejection is improper and should be withdrawn.

Claim 22, upon which claims 23-25 depend, recites in part "recording a base version of a complete song by an artist; mixing a first version of the base version in a studio *under control of the artist*; mixing a second version of the base version in a studio *under control of the artist*; mixing a third version of the base version in a studio *under control of the artist*; encoding the base version on a first track of a storage medium; encoding the first version on a

second track of the storage medium; encoding the second version on a third track of the storage medium; encoding the third version on a fourth track of the storage medium; and *encoding a control track on the storage medium, the control track comprising information for determining which of the base version, first version, second version or third version is to be played.*"

(emphasis added) Alferness does not teach or suggest any control track that would provide the artist mixing the record with control over playback. Indeed, the very purpose of the invention appears to be quite the opposite—for enabling dynamic creation of songs based on user selection and control. The invention set forth in Claim 22 is specifically addressed to enable artistic control over playback and defines relationships among and between the songs—enabling artistic control over their previously composed songs and extending their control to include which of those songs is available for playback and/or when it is to be played. In that way, Alferness appears to teach away from artistic control and instead focused on giving control to the user during playback of a single song. For at least these reasons, the Applicants maintain that the rejection is improper and should be withdrawn.

Claim 26, upon which claims 27-29 and 31 depend, recites in part "mixing a first complete version of a media work; mixing a second complete version of the media work; recording the mixed first complete version of the media work on a first track of a storage medium; recording the mixed second complete version of the media work in a second track of the storage medium; and recording a control track on the storage medium, the control track comprising information for determining which of the first complete version or second complete version of the media work is to be played." Alferness does not teach or suggest recording mixed, complete versions of a media work on individual tracks of a storage medium. Furthermore, given the purpose of the control script of Alferness, i.e., mixing the sounds of the tracks during playback to produce the complete song, the Applicants respectfully contend that Alferness actually teaches away from recording mixed, complete versions of a media work on individual tracks of a storage medium. For at least these reasons, the Applicants maintain that the rejection is improper and should be withdrawn.

Application No. 10/777,381  
RESPONSE TO OFFICE ACTION  
Date: June 3, 2009

PATENT

Date: June 3, 2009

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kurt Schmeer", written over a horizontal line.

Kurt Schmeer  
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